

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN G. WOODS, SUSANNE D. MORRILL,
and ANTHONY F. JACOBINE

Appeal 2007-4260
Application 09/341,287
Technology Center 1700

Decided: September 21, 2007

Before CHUNG K. PAK, THOMAS A. WALTZ, and JEFFREY T. SMITH,
Administrative Patent Judges.

SMITH, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

A review of the present record before us leads us to conclude that this case is not in condition for a decision on appeal. We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2006).

In particular, we remand this application to the Examiner to clarify the record as to the rejections that are on appeal.

Relevant Procedural History

In the Office Action mailed October 3, 2000, the Examiner presented a prior art rejection of claims 1-5, 8-9, and 12-15 under 35 U.S.C. § 103(a) as unpatentable over Okamoto in view of Examiner's [Official] [N]otice, in further view of Wu and Yoshino (¶ 13).¹

In the Final Rejection mailed March 6, 2001, the Examiner presented a prior art rejection of claims 1-5, 8-9, and 12-15 under 35 U.S.C. § 103(a) as unpatentable over Okamoto in view of Examiner's [Official] [N]otice, in further view of Wu and Yoshino (¶ 12).

In the Final Rejection mailed February 20, 2002, the Examiner presented a prior art rejection of claims 23-28, 31, 34-37, 43, and 44 under 35 U.S.C. § 103(a) as unpatentable over Okamoto in view of Admissions by Applicants, Merck Index, Wu, and Yoshino, in further view of Wu or Yoshino (¶ 5).²

Appellants appealed the final rejection of claims 23-28, 31, 34-37, 43, and 44 (See Appeal Brief dated March 22, 2004).

The Examiner in the Answer, mailed April 16, 2004, only identified the Okamoto, Wu, and Yoshino references as the prior art relied upon in the rejection of the claimed subject matter under the prior art listing (Answer 2-

¹ The rejection set forth in this Office action indicated that claims 1-17 and 36-39 had been rejected. However, several of these claims had been withdrawn from consideration by the Examiner in the Office Action. The Examiner clarified that claims 1-5, 8-9, and 12-15 were subject to the prior art rejection in the Office Action mailed March 6, 2001.

² The rejection of claim 25 also appeared in a separate statement over the same cited references (¶ 6).

3). However, the Examiner in the Answer also stated that the rejection set forth in the final Office action mailed February 20, 2002 was relied on to reject claims 23-28, 31, and 34-37 under 35 U.S.C. § 103. As indicated *supra*, this final Office action rejected claims 23-28, 31, 34-37, 43, and 44 under 35 U.S.C. § 103(a) as unpatentable over Okamoto in view of Admissions by Applicants, Merck Index, Wu, and Yoshino, in further view of Wu or Yoshino. However, instead of stating the basis for the rejection, it relied on the Office actions of October 3, 2000 and March 6, 2001. These Office actions do not mention Merck Index and/or Appellants' admission in their statements of the rejections. They also included the Examiner's Official Notice in their statements of the rejections.

Appellants in the Reply Brief, filed May 19, 2004, indicated that the Examiner had failed to identify the Merck Index reference as part of the prior art which was relied upon in rejecting the appealed subject matter (Reply Br. 2). Appellants subsequently stated:

Appellants acknowledge this omission and view it to mean that the rejection of the claims based on all four references, i.e., Okamoto, Merck Index, Wu and Yoshino, has been **withdrawn** and that **only** the rejection of the claims based on Okamoto, Wu and Yoshino has been **maintained**.

(Reply Br. 2).

The Examiner, in response to Appellants Reply Brief, indicated the following:

“The reply brief filed 19 May 2004 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.” (Response dated July 9, 2004).

In view of the above confusing procedural history of the present application, it is not clear what rejection is before us. Specifically, the

record is not clear as to whether Merck Index and/or Appellants' admission is withdrawn or the Examiner's Official Notice is included as part of the prior art relied upon in rejecting the claims on appeal. Moreover, we cannot ascertain how the prior art references are combined in rejecting the claims on appeal since the rejection set forth in the final Office action is based on a combination of the rejections set forth in the previous Office actions discussed above, without any explanation as to how Merck Index and Appellants' admission are combined with the prior art references and the Examiner's Official Notice referred to in the rejections set forth in the previous Office actions.

Upon return of this application, the Examiner is instructed to clearly identify the prior art relied upon in the statement of rejection and set forth a clear basis for rejecting the claims on appeal. The rejection must clearly indicate how the prior art teachings are combined and must identify the appropriate portions of the references that are being relied upon in the statement of the rejection. The Examiner is instructed to submit a Supplemental Examiner's Answer consistent with the instructions above.

ORDER

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to rectify the above-noted matters.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center involved, for appropriate action in view of the above comments.

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This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this Remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

REMANDED

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